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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,382	04/01/2004	Larry G. Ingraham	44018-0002	8271
30734 7590 06/13/2007 BAKER & HOSTETLER LLP WASHINGTON SQUARE, SUITE 1100 1050 CONNECTICUT AVE. N.W. WASHINGTON, DC 20036-5304			EXAMINER DAVIS, CASSANDRA HOPE	
			ART UNIT 3611	PAPER NUMBER
			MAIL DATE 06/13/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/815,382

Applicant(s)

INGRAHAM, LARRY G.

Examiner

Cassandra Davis

Art Unit

3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 28 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-18 and 20-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 12-18, 20-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 25-28, are rejected under 35 U.S.C. 102(b) as being anticipated by Nemzin et al., U. S. Patent 5,223,316.

3. Nemzin teaches a support frame for predetermined characters comprising a 3-D element 12 having a hanger tab 30 for permanently securing the support frame to a wall, a signage donor element 26 and 24. The support frame and the donor elements are made from the same resilient plastic material and are colors contrasting so that the characters can be easily distinguished from the associate holders.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to

a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 12-16 and 20, 21, 23, 24 are is rejected under 35 U.S.C. 103(a) as being unpatentable over Studen U. S. Patent 3,280,499 in view of Nemzin et al., U. S. Patent 5,223,316.

6. Studen teaches a device comprising a three-dimensioned element defining a signage recipient base element (blank 2) and a plurality of signage donor element (portions 14-22), wherein the base element has a plurality of apertures 5-13. The base 2 and donor elements 14-22 are constructed of expanded polyethylene such that the donor element frictionally fit with the apertures 5-13 of the base 2. The friction fit corresponds to the claimed snap-in fit. The donor element has a color different than the color of the base. See column 1, lines 48-55. Nemzin teaches a support frame for predetermined characters comprising a 3-D element 12 having a hanger tab 30 for adhering the support frame to a wall, a signage donor element 26 and 24. The support frame and the donor elements are made from the same resilient plastic material and are colors contrasting so that the characters can be easily distinguished from the associate holders. It would have been obvious to one having ordinary skill

in the art at the time this invention was made to construct the device taught by Studen with a support tab-type holder as taught by Nemzin to provide means to support the device upon a wall.

7. With respect to claim 13, Studen teaches the donor element comprises a plurality of sub-parts (each indivisible punched portion 5-13 and the stencil-like portion or apertures comprises a plurality of separate sub-portions 14-22, with each sub-portion or aperture of the base element having inserted therein one of the donor element sub-parts.

8. With respect to claim 14-16, Studen teaches the color of the donor elements is different than the base element.

9. With respect to claims 20, 21, 23, 34, since the specific indicia does not have an unobvious functional relationship with the signage donor element, it appears that any suitable indicia/indication/message would perform equally well in conveying a desired message.

10. Claims 17 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Studen in view of Nemzin as applied to claim 12 above and in view of Forbes et al., U. S. Patent 6,626,678. Forbes et al teaches a base 42, a frame 43 secured to the base and having a plurality of apertures and a plurality of tiles 44 adapted to fit within the apertures. Each tile has a

layer of soft fabric with different tactility. Forbes also teaches that each tile is distinguishable by color or by the presence of indicia on the textured surfaces. It would have been obvious to one having ordinary skill in the art at the time this invention was made to construct the device taught by Studen and Nemzin with each donor element further be distinguishable by tactility, color, or indicia to provide a means identify one donor or tile element from another.

11. With respect to claims 29-31, since the applicant does not disclose that indicia with phosphorescent, glitter, or photo-luminescent solves any stated problem or is for any particular purpose, it appears that constructing the indicia with any suitable material which contrast with the base or support surface would perform equally well in conveying a desired message.

12. Claim 12 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Studen U. S. Patent 3,280,499 in view of Nemzin et al. as applied to claim 12 above and in further view of Wright, U. S. Patent 2,535,619.

13. Wright teaches a toy comprising a base member 10 having a plurality of cutouts and a plurality of donor element or segments 11, wherein each

segment has a different thickness than the base member. It would have been obvious to one having ordinary skill in the art at the time this invention was made to construct the device taught by Studen and Nemzin with segment having different thicknesses than the base as taught by Wright to provide a means to enhance the aesthetic appearance of the device.

Claim Objections

14. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 30-32 have been renumbered 29-31. Claim 29 was omitted.

Claim Rejections - 35 USC § 112

15. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

16. Claims 12 and 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original specification does not provide support for the base element being configured to be secured in a non-removable manner to a wall or floor. Although the specification recites the base can be "easy to install with standard adhesives and for long lasting adhesion, the backside of the base 2 can be ribbed", the original specification does not state that the base is non-removably secured to a support nor does the specification indicate the adhesive is permanent or non-removable adhesive. ***Response to Arguments***

17. Applicant's arguments filed February 28, 2007 have been fully considered but they are not persuasive. The applicant argues that prior art does not teach, "a base configured to be fixed to in a non-removable manner to a floor or wall," wherein support for this amendment can be found in paragraph [0015].

18. The examiner contends that support tab taught by Nemzin is configured to be non-removable secured to a support. Although the applicant points to paragraph 0015 for support for this limitation. Paragraph [0015] was not found. The original specification does not contain paragraph numbers. On page 6, lines 17-20, the applicant states the base can be installed with standard adhesive. However, the applicant does not indicate that this adhesive is non-removable or permanent adhesive. Since adhesive can take many forms from low tacky removable adhesives to very high tacky permanent adhesive, the mere recitation that the base can be installed using adhesive is insufficient to support the base being non-removably secured to a support.

19. The rejection is maintained.

Conclusion

20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the

THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cassandra Davis whose telephone number is 571-272-6642. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 571-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Cassandra Davis
Primary Examiner
Art Unit 3611

CD
May 29, 2007